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PATENT
Attorney Docket No. TRAC-100FWC CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Examiner: J. Webb
)
 RHONDA TRACY) Group Art Unit: 3761
)
 Serial No.: 09/107,643)
)
 Filed: June 30, 1998)
)
 For: DISPOSABLE DIAPER WITH)
 PADDED WAISTBAND)
 AND PADDED LEGHOLES)

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Rhonda M. Tracy

Date: July 6 2001

APPELLANT'S BRIEF

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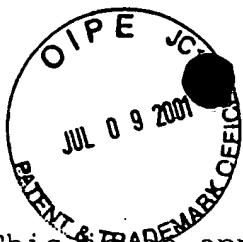
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TABLE OF CONTENTS

REAL PARTY IN INTEREST	1
RELATED APPEALS AND INTERFERENCES	1
STATUS OF CLAIMS	1
STATUS OF AMENDMENTS	1
SUMMARY OF THE INVENTION	2
ISSUES	3
GROUPING OF CLAIMS	3
ARGUMENT	4
A. Applicant is Entitled to the Benefit of the 1987 Filing Date.	4
1. Applicable Caselaw	4
2. The Evidence	5
3. Application to Claim 7	6
4. Application to Claim 8	7
5. Application to Claims 9 and 10	9
6. Application to Claims 11-40	9
B. The Claims are Patentable Over Foreman.	15
1. Foreman (U.S. Patent No. 4,816,025) is not available as a 102(b) reference.	15
2. The Claims Define Patentably Over Foreman (U.S. Patent No. 4,816,025).	16
C. Claims 7-40 are neither anticipated nor obvious under McConnell et al. (U.S. Patent No. 3,461,872).	18

CONCLUSIONS	20
APPENDIX - THE APPEALED CLAIMS	A1
ATTACHMENT A - APPEAL (NO. 95-3512) OPINION	B1



Serial No. 09/107,643

This is an appeal from the last Official Office action (Paper No. 29), mailed March 7, 2001. The Notice of Appeal was filed on May 7, 2001.

REAL PARTY IN INTEREST

The real party in interest in the present application is Rhonda Tracy, the party named in the caption of this brief.

RELATED APPEALS AND INTERFERENCES

A prior appeal (No. 95-3512) before this Board was heard on September 17, 1997 in an ancestor application (No. 08/092,540). A copy of this decision, mailed September 29, 1997, has been made of record in this prosecution. For the convenience of the Board, a copy is attached hereto as Attachment A.

There are no pending related appeals or interferences.

STATUS OF CLAIMS

Claims 7-40 are currently present in this application wherein claims 1, 11, and 31 are independent claims.

Claims 1-6 have been canceled.

All of the remaining claims (7-40) have been finally rejected in the last Office Action (Paper No. 29), and Applicant appeals the rejections of all of those last mentioned claims. A copy of the rejected claims in numerical order and from which this appeal has been taken appears in the Appendix to this brief.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the last Official Office Action (Paper No. 29), mailed March 7, 2001, finally rejecting all of the claims 7-40 in this application.

SUMMARY OF THE INVENTION

The present invention is defined by the claims involved in this appeal. Subject to specific claim language, the disclosed subject matter concerns a disposable diaper where a separate padding or other member has been added at specified locations where a plastic edge is located.

Prior art disposable diapers are typically capable of effective retention of liquid and solid material without having to resort to protective covers as was required by cloth diapers. Nevertheless, the waistband and border around the legholes of these prior art disposable diapers comprise an unprotected plastic band and the like, which are uncomfortable and abrasive to an infant's skin. Also, such diapers do not provide an optimum barrier against leakage and seepage.

The present invention improves over prior art disposable diapers by the addition of another element at the areas where the plastic edge is found. This other element is described in varying ways in the appealed claims: "a soft padding member ..." (claim 7), "strip of non-abrasive material ..." (claim 8), "horizontally oriented strip ..." (claim 11), "discrete member ... having a rectangular shape ..." (Claim 21), and "a strip..." (Claim 31).

With more particular reference to the written specification and drawings, the disposable diaper 2 comprises a body portion 20 having two enlarged end portions 22 and a narrowed intermediate portion 26 therebetween. This body portion 20 is shaped so that the diaper 2 may extend about a waist and crotch of the wearer. The body portion 20 also comprises of two layers 18: a layer of liquid-absorbent material 16b and a plastic layer 16a. Each end portion 22 has a respective waistband portion 10 that girds the waist of the wearer. A soft padding member 50, 64, and 66, (see Second Declaration of Rhonda Tracy, page 3, paragraph 8 and 9),

distinct from the body-portion 20, is located between the diaper wearer and the plastic layer edge 16a, thereby providing the protection from scratches, irritations, and abrasions.

ISSUES

The issues in this appeal are:

1. Whether Applicant should receive the benefit of the 1987 filing date, which the Examiner denies;
2. Whether Foreman (U.S. Patent No. 4,816,025) is available as a 102(b) reference;
3. If Foreman is not a 102(b) reference, whether Applicant has sworn behind Foreman;
4. If Foreman is a 102(b) reference, whether Applicant's rejected claims 7-40 are patentable thereover;
5. Whether Claims 7-40 are patentable over McConnell et al. (U.S. Patent No. 3,461,872).

GROUPING OF CLAIMS

The appealed claims 7-40 should be treated individually. Each claim is patentable in its own right, notwithstanding that other individual claims might be held in the decision in this appeal to be unpatentable over prior art.

Each of the individual claims includes one or more express features which are critically absent even when the prior art is combined as they have been combined to reject the claims here on appeal.

The Examiner treated all of the claims together for purposes of entitlement to the 1987 filing date. This was an error, particularly where each independent claim expresses different aspects of the invention. For example, although claim 11 calls for a "horizontally oriented strip," the Examiner made no visible

effort to compare that claim to the 1987 design application. Instead, the Examiner grouped all of the claims together. They are argued separately herein.

ARGUMENT

A. Applicant is Entitled to the Benefit of the 1987 Filing Date.

On the issue of the filing date to which these claims are entitled, Applicant respectfully submits that the date of filing the design patent application should be accorded to this subject matter. That date is September 8, 1987 for Serial No. 093,681. The title of that application was "Ornamental Design for a Disposable Diaper." That 1987 application showed the same subject matter of Figs. 1, 2, and 3 of the present application, but it did not include the written description thereof nor did it include the reference numerals that were introduced in the utility application filed on April 30, 1990.

1. Applicable Caselaw

The Federal Circuit has considered priority claims from a utility patent to a previously filed design patent application. In Vas-Cath v. Mahurkar, 19 USPQ2d 1111 (Fed. Cir. 1991), reversing the district court below, the court mentioned the following:

- The prior application does not have to describe exactly the subject matter claimed. The description must clearly allow persons of ordinary skill in the art to recognize that the applicant invented what is claimed. 19 USPQ2d at 1116, citing In re Gosteli, 872 F2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

- The test for sufficiency of support in a parent application is whether its disclosure reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. Id. citing Ralston Purina v. Far-Mar-Co., 772 F2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).
- There is no statutory prohibition against an applicant relying on the disclosure of a design application, if the statutory conditions are met. Id. at 1117. The practical, legitimate inquiry in each case is what the drawing discloses to one skilled in the art. It appears to be inconsequential whether the support comes from specification or drawings. Id. at 1118, citing In re Wolfensperger, 302 F2d. 950, 133, USPQ 537 (CCPA 1962).
- Consideration of what the drawings conveyed to persons of ordinary skill is essential. Id. at 1119.

2. The Evidence

Applicant has made two declarations of record on the issue. The (first) Declaration of Rhonda Tracy is dated January 28, 1999, and a second Declaration of Rhonda Tracy is dated April 18, 2000. These declarations provide evidence that supports how and why the 1987 design application supports the pending claims.

In these declarations, the Applicant describes her abandoned 1987 design patent application. That 1987 application showed the same subject matter of Figs. 1, 2, and 3 of the present application, but it did not include the written description thereof nor did it include the reference numerals that were introduced in the utility application filed on April 30, 1990. The declaration offers evidence how persons of ordinary skill in

the art of diaper design would understand each component of 1987 application, and how each of these features of the 1987 design application has been claimed in the present utility application.

3. Application to Claim 7

Independent claim 7 claims the aspect of the outer strip 50 of the preferred embodiment to the extent that it is "a soft padding member." Claim 7 further specifies that the soft padding member includes a material formed from a soft substance...so that the diaper presents a soft surface at the inside of the diaper waistband portion despite the plastic layer edge. The plastic layer edge will be discussed below with regard to claim 8. The main issue with claim 7 concerns the limitations regarding softness.

In page 7 of the Final Rejection, the Examiner held that a fabric outer strip 22 in McConnell inherently is soft and non-abrasive, or [alternatively] would have been obvious to one of ordinary skill in the art "because it is well recognized that babies' skin is soft and easily irritated...One of ordinary skill would not cover an elastic band with a hard or abrasive material, as that would defeat the purpose of covering it." While Applicant does not concede that McConnell discloses or suggests the present invention, Applicant asserts that the disclosure of the material in her 1987 design application drawings are fairly interpreted as soft padding members.

Applicant's assertion is supported by the evidence of record, including the first and second declarations of Rhonda Tracy on this subject. It would be very strange indeed if the member shown at the waistband and leg holes of the design patent application were hard or abrasive. If they were, they simply would not be suitable for use in the location of a disposable diaper to be used on the tender skin of a baby. In the Second

Declaration, the Applicant accordingly provides, "In my opinion, the worker of ordinary skill in the art of diaper design in 1987 would have understood this member to be soft rather than hard and brittle and further would have understood it to be non-abrasive. Abrasive material would be unsuitable for contact with the skin of babies in the waist and crotch area. "

Thus, Applicant submits that the subject matter of claim 7 is entitled to December 8, 1987 as its effective filing date.

4. Application to Claim 8

Independent claim 8 also is clearly entitled to the 1987 filing date. Rather than reciting "a soft padding member" as in claim 7, claim 8 instead calls for "a strip of non-abrasive material" at a specified location.

Inspection of the 1987 design application drawings shows readily that there is a strip of material located in the portions recited and claimed in pending claim 8. With regard to the limitation that the strip is "non-abrasive," it is respectfully noted that the Examiner himself has held that the "non-abrasive" feature was either inherent or would have been obvious (for purposes of construing prior art). If that test is applied against the Applicant, why can it not be applied to her benefit also? It seems unfair for the Examiner to infer something from the prior art and not infer it from the Applicant's drawings.

It is also evident that the 1987 design patent application clearly contemplated a plastic layer having a plastic layer edge. The title given to the design patent application referred to a disposable diaper. Disposable diapers from before that time frame, through today, include a plastic layer outward from the liquid absorbent core of the diapers. The plastic layer is to be liquid impervious, and acts as an outer containment layer. The design drawings show such an outer layer. By September 8, 1987

(the filing date), one of ordinary skill in the art would have understood that in a disposable diaper (according to the title of the application), a plastic layer was contemplated. Moreover, the specification of Tracy in U.S. Patent 5,797,824, using the same drawings but with a written description added, indicates that the disposable diaper includes "an outer liquid impervious outer sheet 16a and an inner liquid permeable sheet 16b as is well known." Col. 2, lns. 8-10. Hence, the same outer layer of the design patent is the plastic layer of the illustrated embodiment of the present application.

Next, the edge of the plastic sheet 16a is seen in the sectional drawing filed in 1987 as part of the design application. The sectional view as described in the design application is taken along the section line 3-3 of **Fig. 2**. There is no reason why the ordinarily skilled artisan would conclude that the plastic layer would go to the edge of the diaper along the leg holes and not do the same in the waistband area. Accordingly, it cannot be seriously challenged that as of her 1987 filing date, the Applicant was in possession of this feature (the plastic layer has an edge at the diaper edge by the waistband) of the subject matter now specified in claim 8.

Likewise, it is undeniable that the strip of material shown in the 1987 design patent drawings is "distinct from all of said body-portion layer." It is clearly seen as a separate element of the diaper, rather than a mere extension of any body portion.

Finally, it is respectfully submitted that the design drawings do show that this strip of claim 8 provides a cushion. It is clearly seen to be located between what must be a plastic layer edge and the body of the wearer, and it provides added cushioning. In the Second Declaration, the Applicant submits that the padding members that were added to the waistband and the leg hole regions "would have been understood to provide a soft

surface. Further, I [the Applicant] believe they would have been understood to provide padding or a cushion effect."

Accordingly, Applicant respectfully submits that all of the subject matter of pending independent claim 8 is entitled to the September 8, 1987 filing date of Serial No. 093,681 for her design patent application.

5. Application to Claims 9 and 10

The figures of the 1987 design application clearly show a strip has been added around most of the periphery of the diaper -- at both the narrowed intermediate (crotch) portion of the diaper and on both waistbands. Fig. 1 shows clearly that this added strip is on the diaper exterior, where it extends from the inside to the outside of the diaper, along the waistband and the leg holes. The sectional drawing shows how the strip wraps over the ends. Accordingly, the subject matter of claims 9 and 10 (the strip or soft padding member extends from inside to outside the diaper, wrapping over the plastic edge) is clearly disclosed in the 1987 design patent application.

6. Application to Claims 11-40

Claims 11-40, including three independent claims 11, 21, and 31, are clearly entitled to the 1987 priority date.

Claim 11. The 1987 design application disclosed a disposable diaper having added a horizontally-oriented strip that was distinct from the top and bottom sheets. This strip was located at the waistband between the plastic edge and the wearer. **Fig. 2** clearly shows this horizontally-oriented strip 50 that is distinct from the top 16b and bottom 16a sheets as shown in **Fig. 4.**

Accordingly, the 1987 application discloses the claimed horizontally-oriented strip, and this claim is entitled to the 1987 priority date.

Claim 12. In page 3 of the second declaration, the Applicant states that the ordinarily skilled diaper designer would have believed that the horizontally-oriented strip of the 1987 application discussed above "would be understood to provide a padding or a cushion effect." The 1987 application accordingly discloses the claim 11 strip 50 as being a padding member, and this claim is entitled to the 1987 priority date.

Claim 13. In page 3 of the second declaration, the Applicant states that the ordinarily skilled diaper designer would have believed that the horizontally-oriented strip of the 1987 application discussed above "would be understood to provide a padding or a cushion effect." The 1987 application accordingly discloses the claim 11 strip 50 as being a cushion, and this claim is entitled to the 1987 priority date.

Claim 14. The 1987 design application provided a configuration of a disposable diaper with the horizontally-oriented strip of the 1987 application discussed above. In page 3 of the second declaration, the Applicant states that "the threading and elastic [of prior art diapers] would rub against the skin throughout the day with normal wear, and thus were flawed from a comfort perspective." Her diaper design was configured in such a manner to overcome this. Accordingly, the 1987 application provides a configuration of a diaper that softens the effect on the skin of the wearer by using a horizontally-oriented strip 50 located at the waistband 10 between the plastic edge 40 and the wearer, and this claim is entitled to the 1987 priority date.

Claim 15. The 1987 design application provided a disposable diaper with the horizontally-oriented strip of the 1987 application discussed above. Clearly, this strip positioned between the edge and wearer would constitute an additional barrier against leakage. Accordingly, the 1987 application

discloses the horizontal orientation of the strip 50 located at the waistband 10 between the plastic edge 40 and the wearer to provide an additional barrier against leakage, and this claim is entitled to the 1987 priority date.

Claim 16. The 1987 design application disclosed a disposable diaper with the horizontally-oriented strip of the 1987 application discussed above. This design application clearly showed that this strip was adjacent to the plastic edge. Accordingly, the 1987 application discloses the strip 50 being adjacent to the plastic edge 40 as shown in Fig. 4, and this claim is entitled to the 1987 priority date.

Claim 18. The 1987 design application disclosed a disposable diaper with the horizontally-oriented strip of the 1987 application discussed above. This design application clearly showed that this strip was parallel to the waistband. Accordingly, the 1987 application discloses the strip 50 being parallel to the waistband 10 as shown in Figs. 1 and 2, and this claim is entitled to the 1987 priority date.

Claim 21. The 1987 design application disclosed a disposable diaper having a discrete member, interposed between the plastic edge and the wearer. This member is rectangular in shape and located substantially only at the waistband and extending horizontally with respect to the plastic edge. Fig. 2 clearly shows this discrete rectangularly shaped member 50 that is interposed between the plastic edge 40 and the wearer. Figs. 1 and 2 show that this discrete member 50 is located substantially only at the waistband 10 and extends horizontally with respect to the plastic edge 40. Accordingly, the 1987 application supports this claim, and this claim is entitled to the 1987 priority date.

Claim 22. In page 3 of the second declaration, the Applicant states that the ordinarily skilled diaper designer would have believed that the discrete member 50 of the 1987 application discussed above "would be understood to provide a padding or a cushion effect." The 1987 application accordingly discloses the claim 21 discrete member 50 as being a padding member, and this claim is entitled to the 1987 priority date.

Claim 23. In page 3 of the second declaration, the Applicant states that the ordinarily skilled diaper designer would have believed that the discrete member of the 1987 application discussed above "would be understood to provide a padding or a cushion effect." The 1987 application accordingly discloses the claim 21 discrete member 50 as being a cushion, and this claim is entitled to the 1987 priority date.

Claim 24. The 1987 design application clearly shows the discrete member providing a discrete thickness between the plastic edge and the wearer. Fig. 4 shows the discrete member 50 providing this discrete thickness between the plastic edge 40 and the wearer. Accordingly, the 1987 application discloses the discrete member 50 providing this discrete thickness, and this claim is entitled to the 1987 priority date.

Claim 25. The 1987 design application disclosed a disposable diaper with the discrete member of the 1987 application discussed above. This design application clearly showed that this strip was adjacent to the plastic edge. Accordingly, the 1987 application discloses the discrete member 50 being adjacent to the plastic edge 40 as shown in Fig. 4, and this claim is entitled to the 1987 priority date.

Claim 26. The 1987 design application provided a disposable diaper with the discrete member of the 1987 application discussed above. Clearly, this member positioned between the edge and wearer would constitute additional barrier against leakage.

Accordingly, the 1987 application discloses that the discrete member 50 located at the waistband 10 between the plastic edge 40 and the wearer to provide an additional barrier against leakage, and this claim is entitled to the 1987 priority date.

Claim 28. The 1987 design application disclosed a disposable diaper with the discrete member of the 1987 application discussed above. This design application clearly showed that this strip was parallel to the waistband. Accordingly, the 1987 application discloses the strip 50 being parallel to the waistband 10 as shown in Figs. 1 and 2, and this claim is entitled to the 1987 priority date.

Claim 31. The 1987 design application disclosed a disposable diaper having added a strip that was distinct from the top and bottom sheets. This strip was located at the edge of a leg hole between the plastic edge and the wearer. Fig. 2 clearly shows this strip 64 and 66 that is distinct from the top 16b and bottom 16a sheets as shown in Fig. 3. Accordingly, the 1987 application discloses this strip, and this claim is entitled to the 1987 priority date.

Claim 32. In page 3 of the second declaration, the Applicant states that the ordinarily skilled diaper designer would have believed that the strip of the 1987 application discussed above "would be understood to provide a padding or a cushion effect." The 1987 application accordingly discloses the claim 31 strip 64 and 66 as being a padding member, and this claim is entitled to the 1987 priority date.

Claim 33. In page 3 of the second declaration, the Applicant states that the ordinarily skilled diaper designer would have believed that the strip of the 1987 application discussed above "would be understood to provide a padding or a cushion effect." The 1987 application accordingly discloses the

claim 31 strip 64 and 66 as being a cushion, and this claim is entitled to the 1987 priority date.

Claim 34. The 1987 design application provided a configuration of a disposable diaper with the strip of the 1987 application discussed above. In page 3 of the second declaration, the Applicant states that "the threading and elastic [of prior art diapers] would rub against the skin throughout the day with normal wear, and thus were flawed from a comfort perspective." Her diaper design was configured in such a manner to overcome this. Accordingly, the 1987 application provides a configuration of a diaper that softens the effect on the skin of the wearer by using a strip 64 and 66 located at the edge of a leg hole 14 between the plastic edge 60 and the wearer, and this claim is entitled to the 1987 priority date.

Claim 35. The 1987 design application provided a disposable diaper with the strip of the 1987 application discussed above. Clearly, this strip positioned between the edge and wearer would constitute a barrier against leakage. Accordingly, the 1987 application discloses the horizontal orientation of the strip 64 and 66 located at the edge of a leg hole 14 between the plastic edge 60 and the wearer to provide an additional barrier against leakage, and this claim is entitled to the 1987 priority date.

Claim 36. The 1987 design application disclosed a disposable diaper with the strip of the 1987 application discussed above. This design application clearly showed that this strip was adjacent to the plastic edge. Accordingly, the 1987 application discloses the strip 64 and 66 being adjacent to the plastic edge 60 as shown in Fig. 3, and this claim is entitled to the 1987 priority date.

Claim 38. The 1987 design application disclosed a disposable diaper with the strip of the 1987 application discussed above. This design application clearly showed that

this strip was parallel to the leg hole. Accordingly, the 1987 application discloses the strip 64 and 66 being parallel to a leg hole 12 as shown in Figs. 1 and 2, and this claim is entitled to the 1987 priority date.

Thus, Applicant submits that the subject matter of claims 11-40 is entitled to September 8, 1987 as their effective filing date.

B. The Claims are Patentable Over Foreman.

1. Foreman (U.S. Patent No. 4,816,025) is not available as a 102(b) reference And Tracy Can Swear Behind It.

On the basis that claims 7-40 are entitled to a September 1987 effective filing date, Applicant respectfully submits that the rejection of claims 7-40 over Foreman alone or in combination with other references can be (and has been) overcome. Because the Examiner refused to accord any claims the benefit of the 1987 filing date, he held that Foreman is a 102(b) reference which cannot be sworn behind, and the Examiner applied it as a reference. Applicant asserts that (i) Foreman is not a 102(b) reference because Applicant is entitled to her 1987 date, and (ii) even if Foreman were a 102(b) reference, the rejected claims distinguish thereover.

Foreman issued as a patent on March 28, 1989, which is many months junior to the filing date of the Tracy design patent application in 1987. Since the Applicant is entitled to the benefit of her 1987 filing date, for reasons discussed above, Foreman is not a Section 102(b) reference against these claims. As such, it can be sworn behind, and Applicant has already submitted papers doing just that. The (first) Declaration of Rhonda Tracy dated January 28, 1999 attests,

"I conceived my invention prior to October 10, 1986***.

I created a model of my invention before my first

meeting with my first patent attorney, Roger Van Epps, and I left my prototype with him at the first meeting***. I created my prototype prior to October 3, 1986."

For the reasons discussed above, Applicant respectfully requests the Board to reverse the rejection that claims 7-8, 11-13, 15-16, 18, 21, 23-26, 28, 31, 33-36, and 38 are fully met by Foreman U.S. Patent 4,816,025, as indicated in paragraphs 4-13 of the Final Rejection.

Moreover, Applicant respectfully requests the reversal of the rejection using Foreman in combination with Lindquist as stated in paragraphs 17-20 of the Final Rejection. For the reasons discussed, Foreman is not available as a 102(b) reference to be used in such a hypothetical combination.¹

2. The Claims Define Patentably Over Foreman (U.S. Patent No. 4,816,025).

Paragraphs 5-15 finally rejected claims 7-8, 11-13, 15-16, 18, 21, 23-26, 28, 31, 33-36, and 38 over Foreman U.S. Patent 4,816,025 as being completely anticipated. The Applicant traverses and appeals the assertion in Paragraph 4 that Foreman discloses a soft padding member located along a waistband portion adjacent to the outer layer edge.

The evidence of record includes the (first) Declaration of Rhonda Tracy dated January 28, 1999, the second Declaration of Rhonda Tracy dated April 18, 2000, and the reference itself. In the Amendment mailed January 29, 1999, the undersigned explained that claim 7 requires a soft padding member which must include a material formed from a soft substance. We explained that Foreman

¹Applicant does not waive her arguments that are of record to distinguish her invention from Foreman and the postulated combination(s) using Foreman.

has second barrier cuffs 262 (which the Examiner specifically cites). These are part of the barrier cuffs which trap exudate from the baby or other diaper wearer. These barrier cuffs form a pocket. As explained in Amendment B, to the extent that the Foreman patent refers to a soft edge 266, this is merely because the end of the barrier cuff is looped back upon itself to form a tunnel. The flap that is in the waistband region is not said to include any soft padding material, we submit.

In Paragraph 17-20, the Examiner rejected claim 7 as obvious over Foreman in view of Lindquist U.S. Patent 3,572,342. This rejection is traversed and appealed. The Examiner relies on Lindquist which includes elements 37 and 38 made of foam along portions of a diaper at which the seepage of fluids is not desired.

However, as stated in Amendment B, this combination also does not render the subject matter of claim 7 obvious. The Lindquist diaper includes sealing strips, 37, 38 which extend laterally across the diaper to confine the area of wetness, hopefully allowing another part of the diaper to remain dry. Applicant finds no disclosure in Lindquist of using such strips adjacent to the actual waist edge, as required by one of the features of claim 7, or of using the strips for softening the effect of an edge of a plastic layer in a diaper. The Examiner cannot arbitrarily combine citations to meet the features of a claim for purposes of a rejection under Section 103. There must be some suggestion in the field of knowledge to combine the various elements as asserted by the Examiner. The only assertion by the Examiner in this regard appears at Col. 11 wherein the Examiner asserts that it would have been obvious to provide the "upper surface of barrier cuffs 62 and 262 of Foreman with padding elements made of foam, as disclosed by Lindquist, in order to retard fluid." This appears to be an arbitrary

substitution by the Examiner. Indeed, the Examiner seems to conflate the two different teachings of these two different references. Foreman concerns exudate guards, and the Examiner arbitrarily would provide a foam padding on top of the exudate guards to control wetness. There is no suggestion, we submit, in either Foreman or Lindquist for combining exudate guards with these foam of other sealing strips of Lindquist. It certainly does not appear that Foreman requires the use of two different types of guards. Accordingly, this basis of rejection should be reversed.

C. Claims 7-40 are neither anticipated nor obvious under McConnell et al. (U.S. Patent No. 3,461,872).

In Paragraphs 21-27 of the Final Rejection, claims 7-40 were rejected as anticipated by McConnell et al. 3,461,872 or as obvious thereover. McConnell was previously before this Board as a secondary reference in a parent application. As already announced by this Board on page 7 of that opinion, the "diaper retaining garment" disclosed by McConnell is of no help in remedying the deficiencies of the prior art. Therefore, McConnell is inadequate as a secondary reference, let alone a primary reference as cited by the Examiner in his Final Rejection.

Nevertheless, the Examiner rejected claims 7-40 based solely upon McConnell. In response to the Examiner's rejection, the Applicant reiterates that McConnell appears to be what has been referred to as "rubber pants." It is not a disposable diaper but instead is a "diaper retaining garment." One places a disposable diaper in the McConnell garment so that it is "in position adjacent the perineal region of a wearer." Col. 1, lns 22-23.

McConnell does not disclose a diaper including a plastic layer extending to the edge of the diaper and including a plastic

edge at the edge of the diaper at a waistband. More specifically, this garment includes perimeter bands along edges 11, 12, 18 and 19. There are snap fasteners between each of these four edge bands. Reference is made to an elasticized strip 21 which as seen in Fig. 2 is present at these outer bands. However, as plainly can be seen in Fig. 2, those bands do not form an entire layer of material. Claim 7 at line 8 specifies "a plastic layer having an edge at the edge of the diaper." The Examiner points to no such structure in McConnell. Claim 8 specifies "at least two body-portion layers including... a plastic layer having an edge at the edge of the diaper." Claim 8, lns. 7-8.

The Examiner specifically points to element 22 in McConnell. However, McConnell is for a "diaper retaining garment." Like the rubber pants of yesteryear, this clearly is not a diaper itself, as seen from the opening paragraphs of this citation:

"In the past, many garment constructions have been devised for the purpose of retaining and supporting a diaper in position on a wearer.*** In practice, the diaper supporting and retaining garment is reused many times while the disposable diaper pads are discarded after becoming soiled in use.*** Therefore, it is an object of the present invention to provide a new and improved diaper retaining garment."

Cols. 1-2, *passim*. Simply put, McConnell does not disclose nor suggest adding soft padding or cushioning to a disposable diaper. It discloses the addition of a fabric outer strip 22 to prevent contact of the wearer with the elastic material which form strip 21 of a separate "garment" that holds a diaper in place. McConnell is intended to be used with a disposable diaper that fits inside of the retaining garment, as contemplated in Figs. 5

and 6. Thus, Fig. 5 shows the disposable pad which is separate from the outer retainer shown in Fig. 1. The combination of the two is seen in Fig. 6.

McConnell teaches that the covering 22 extends over an elasticized material. The construction of the diaper using an elastic material 21, which wraps from inside to outside of the retaining garment, as shown in Fig. 2, is described in Col. 3 at lines 5-30. The elastic material 21 is added as a further member to give the garment shape. Then, to prevent contact of the elastic material 21 with the skin of the wearer, McConnell et al. adds "fabric outer strip 22." There is no teaching here that the fabric outer strip 22 is to prevent contact of the wearer with the plastic edge. Instead, it is for the purpose of avoiding contact with elastic material.

Independent claims 7 and 8 talk about using the soft padding member or the strip for diverting the effect of a plastic layer edge. This is a different problem than dealing with elastic material.

In addition, there is no suggestion in McConnell et al. of integrating the strip 22 of McConnell, even if it were deemed to be padding or a cushion, onto a unified disposable diaper. Instead, this is for a separate diaper retaining garment. The Applicant's claims, on the other hand, call for a disposable diaper rather than a diaper retaining garment.

The undersigned therefore appeals the rejection based on McConnell, which clearly is deficient, and requests reversal of this rejection.

CONCLUSIONS

The Applicant is entitled to the benefit of the 1987 filing date; therefore, Foreman should not be available as a 102(b)

reference. However, even if the Board finds that Foreman is a 102(b) reference, the Applicant's claims define patentably over Foreman. Moreover, McConnell does not disclose nor suggest the important purposes and goals of the present invention, much less that certain features as claimed should be employed to reach either these purposes or goals or any other purpose or goal. For the above reasons, it is respectfully submitted that the rejection of all of the claims on appeal, claims 7-40 of the present application, must be reversed.

Respectfully submitted,

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Dated: July 6, 2001



Serial No. 09/107, 643

APPENDIX - THE APPEALED CLAIMS

7. A disposable diaper comprising:

a body portion having two enlarged end portions and a narrowed intermediate portion therebetween, the body portion being shaped so that said diaper may extend about a waist and crotch of a wearer and have an inside and an outside with respect to the wearer;

each end portion having respective waistband portion at an edge thereof so that when the diaper is worn, the waistband portions gird the waist of the wearer;

at least two body-portion layers including a layer of liquid-absorbent material and a plastic layer having an edge at the edge of the diaper;

a soft padding member located along at least one of said waistband portions, being adjacent to said plastic layer edge, the soft padding member being distinct from all of said body-portion layer, the soft padding member including a material formed from a soft substance so that the soft substance is located between the diaper wearer and the plastic layer edge, so that the diaper presents a soft surface at said inside of the diaper waistband portion despite said plastic edge.

8. A disposable diaper comprising a body portion having two enlarged end portions and a narrowed intermediate portion therebetween, the body portion being shaped so that the diaper may extend about a waist and crotch of a wearer and having an inside and an outside with respect to the wearer;

each end portion having a respective waistband portion at an edge thereof so that when the diaper is worn, the waistband portions gird the waist of the wearer;

at least two body-portion layers including a layer of liquid-absorbent material and a plastic layer having an edge at the edge of the diaper;

a strip of non-abrasive material located along at least one of said waistband portions, being substantially adjacent to said plastic layer edge, said strip being distinct from all of said body-portion layer, said strip providing a cushion between the diaper wearer and the plastic layer edge so that the diaper presents a cushioned surface at said inside of the diaper waistband portion despite said plastic layer edge.

9. The disposable diaper of claim 8 wherein said strip extends from the inside of the diaper to the outside of the diaper, wrapping over said plastic layer edge.

10. The disposable diaper of claim 7 wherein said soft padding member extends from the inside to the outside of said diaper, wrapping over said plastic layer edge.

11. A disposable diaper to be worn by a wearer, the diaper being of the type having a body portion with top and bottom sheets and an absorbent core therebetween, the diaper including a plastic layer extending to and including a plastic edge at an edge of the diaper at a waistband, wherein the improvement comprises:

a horizontally oriented strip, said strip being distinct from the top and bottom sheets, said strip being located at the waistband between the plastic edge and the wearer.

12. The diaper of claim 11 wherein the strip is a padding member.

13. The diaper of claim 11 wherein the strip is a cushion.

14. The diaper of claim 11 wherein the strip is configured to soften the effect on the skin of the wearer of the plastic edge.

15. The diaper of claim 11 wherein the strip is positioned to provide an additional barrier against leakage.

16. The diaper of claim 11 wherein the strip is adjacent to the plastic edge.

17. The diaper of claim 11 wherein the strip is absorbent.
18. The diaper of claim 11 wherein the entire strip is parallel to waistband.
19. The diaper of claim 11 wherein the strip is an absorbent padding member positioned to provide an additional barrier against leakage, located parallel to the waistband and adjacent to the plastic edge.
20. The diaper of claim 11 wherein the strip is absorbent, positioned to provide an additional barrier against leakage, located parallel to the waistband, and adjacent to the plastic edge.
21. A disposable diaper to be worn by a wearer, the diaper being of the type having a body portion with top and bottom sheets and an absorbent core therebetween, the diaper including a plastic layer extending to and including a plastic edge at an edge of the diaper at a waistband, wherein the improvement comprises:
a discrete member, interposed between said plastic edge and the wearer, said member having a rectangular shape and being located substantially only at the waistband and extending horizontally with respect to the plastic edge.
22. The diaper of claim 21 wherein the discrete member is configured to soften the effect on the skin of the wearer of the plastic edge.
23. The diaper of claim 21 wherein the discrete member provides a cushion.
24. The diaper of claim 21 wherein the discrete member provides a discrete thickness between the plastic edge and the wearer.
25. The diaper of claim 21 wherein the discrete member is adjacent to the waistband and the plastic edge.

26. The diaper of claim 21 wherein the discrete member is positioned to provide an additional barrier against leakage.

27. The diaper of claim 21 wherein the discrete member is absorbent.

28. The diaper of claim 21 wherein the discrete member is parallel to the waistband.

29. The diaper of claim 21 wherein the discrete member is an absorbent padding member positioned to provide an additional barrier against leakage, located parallel to the waistband and adjacent to the plastic edge.

30. The diaper of claim 21 wherein the discrete member is absorbent, positioned to provide an additional barrier against leakage, located parallel to the waistband, and adjacent to the plastic edge.

31. A disposable diaper to be worn by a wearer, the diaper being of the type having a body portion with top and bottom sheets and an absorbent core therebetween, the diaper including a plastic layer extending to and including a plastic edge at an edge of the diaper at a leg hole, wherein the improvement comprises:

a strip, distinct from the top and bottom sheets, and located at the leg hole, between the plastic edge and the wearer.

32. The diaper of claim 31 wherein the strip is a padding member.

33. The diaper of claim 31 wherein the strip is a cushion.

34. The diaper of claim 31 wherein the strip is configured to soften the effect on the skin of the wearer of the plastic edge.

35. The diaper of claim 31 wherein the strip is positioned to provide an additional barrier against leakage.

36. The diaper of claim 31 wherein the strip is adjacent to the plastic edge.

37. The diaper of claim 31 wherein the strip is absorbent.
38. The diaper of claim 31 wherein the strip is parallel to leg hole.
39. The diaper of claim 31 wherein the strip is an absorbent padding member positioned to provide an additional barrier against leakage, located parallel to the leg hole and adjacent to the plastic edge.
40. The diaper of claim 31 wherein the strip is absorbent, positioned to provide an additional barrier against leakage, located parallel to the leg hole, and adjacent to the plastic edge.

Serial No. 09/107,643

ATTACHMENT A - APPEAL (NO. 95-3512) OPINION

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 29 1997

PAT. & TM. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

R E C E I V E D
OCT 6 1997

Ex parte RHONDA TRACY

Appeal No. 95-3512
Application 08/092,540¹

COOK, MCQUADE & MANZO

HEARD: September 17, 1997

Before McCANDLISH, Senior Administrative Patent Judge, and STAAB and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 26 through 39 and 41, all of the claims pending in the application.

CONVENTIONAL
INNER PRIORITY ORDER

¹ Application for patent filed July 16, 1993. According to the appellant, the Application is a continuation of Application 07/790,469, filed November 12, 1991, now abandoned, which is a continuation of Application 07/516,473, filed April 30, 1990, now U.S. Patent No. 5,064,421, which is a continuation of Application 07/093,681, filed September 8, 1987, now abandoned.

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EXHIBIT
No. 3
Tracy 09/107,643

The invention relates to "a disposable diaper having a padded waistband and legholes" (specification, page 1). Claim 26 is illustrative and reads as follows:

26. A disposable diaper comprising:

a body portion having two enlarged end portions and a narrowed intermediate portion therebetween, the body portion being shaped so that said diaper may extend about a waist and crotch of a wearer and have an inside and an outside with respect to the wearer;

each end portion having a respective waistband portion at an edge thereof so that when the diaper is worn, the waistband portions gird the waist of the wearer;

at least two body-portion layers including a layer of liquid-absorbent material and a plastic layer having an edge at the edge of the diaper;

a soft padding member located along at least one of said waistband portions, being adjacent to said plastic layer edge, the soft padding member being distinct from all of said body-portion layer, the soft padding member including a material formed from a soft substance presenting a soft surface along at least a portion of said inside of the diaper waistband portion despite said plastic layer edge.

The references relied upon by the examiner as evidence of obviousness are:

McConnell et al. (McConnell) Gilles	3,461,872 4,728,326	Aug. 19, 1969 Mar. 1, 1988 (filed Jan. 2, 1986)
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Claims 26 through 39 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gilles in view of McConnell.

CONFIDENTIAL
UNDER PROTECTIVE ORDER

Gilles discloses an adjustable diaper 10 having a body portion 12. As described in the reference,

[t]he body portion has a relatively narrow central portion 22 formed by gathers 24 and 26 prior to stitching at 28 and 30 near the sides 14 and 16. This produces a concave interior for a better fit. The body portion also has a front part 34 generally adjacent front end 18 and a back part 32 generally adjacent back end 20.

The body portion is made of a flexible sheet-like material, preferably cotton flannelette. Two layers of fabric 36 and 38 are used as seen in FIG. 4. Internally, additional somewhat trapezoidal-shaped layers of fabric are used for absorbency purposes. These are sandwiched together as seen in FIG. 4. The outer layers 40, 42, 44 and 46 extend from the central portion 22 into the back part 32 and the front part 34. Two additional layers 48 and 50 occur between layers 42 and 44 and extend from the central portion into the front part. The layers 40-50 are held in position between layers 36 and 38 by stitching 52 shown in FIG. 3.

The sides of the body portion are finished by cloth strips 54 and 56 folded over the edges and sewn in place by stitching 30 and 28 shown in FIG. 4. The use of gathers 24 and 26 in combination with cloth strips 54 and 56 and stitching 30 and 28 provides a more comfortable fit than the elastic portions used in prior art fitted diapers. FIG. 5 shows strip 54 in section. At front end 18 [a] layer of cloth 38 is folded over to form a portion 62 overlaying layer 36 and held in position by stitching 64.

At back end 20 the diaper has a pair of strap members 66 and 68 which form outer extensions of a waist band 70. As seen best in FIGS. 3, 4 and 6, the waist band 70 is formed of a single strip of cloth folded and with stitching 72 and 74 extending along opposite sides thereof [column 2, lines 29 through 62].

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UNDER PROTECTIVE ORDER

McConnell discloses a diaper retaining garment "for retaining a diaper, generally of the disposable type, in position adjacent the perineal region of a wearer" (column 1, lines 21 through 28). The garment consists of a generally rectangular sheet of flexible polymeric cellular material having snap fasteners secured at its four corners. Folded about the side and end edges of the sheet are an elastic strip 21 and an overlying outer strip 22 which is preferably made of a woven fabric or scrim. The purpose of the outer strip 22 is "to prevent contact of the wearer with the elastic material forming strip 21" (column 3, lines 32 and 33).

In explaining the rejection on appeal, the examiner states that:

Gilles discloses the invention substantially as claimed with at least two body portion layers (42, 44, 46, 48, and 50) that include a liquid absorbent layer and soft absorbent padding members (54, 56, and 70) formed of cloth along the leg portions and at least one of the waistband portions, however, Gilles does not teach the padding at the waistband to extend around from the inside to the outside and one of the layers to include plastic.

McConnell teaches it is old and well known within the art to those of ordinary skill in that art to provide padding (22) that is of absorbent cloth extending around from the inside to the outside of the waistband (lines 30-39 of column 3).

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UNDER PROTECTIVE ORDER

As to the plastic limitation, whether one of the layers is plastic or one of the materials taught by Gilles is considered an obvious matter of design choice to one of ordinary skill within the art as determined by what material is considered most appropriate for the article and in view of the fact that the inventive concept of shielding the wearer from discomfort from rough edges is not a function of the material in the layers.

It would have been obvious to said artisan to modify Gilles per the above cited teachings of McConnell to provide a waistband that feels more comfortable to the wearer [final rejection, Paper No. 19, pages 3 and 4].

Claims 26, 34 and 41, the three independent claims on appeal, recite with varying degrees of specificity a disposable diaper comprising, inter alia, a plastic layer or material at or extending to a waistband edge of the diaper and an associated soft padding member. More particularly, claim 26 requires "a plastic layer having an edge at the edge of the diaper" and "a soft padding member located along at least one of said waistband portions, being adjacent to said plastic layer edge . . . including a material formed from a soft substance presenting a soft surface along at least a portion of said inside of the diaper waistband portion despite said plastic layer edge." Claim 34 sets forth "a plastic material extending to an edge of the body portion [of the diaper]" and "a first soft padding member . . . including a strip of a soft substance located along at

CONFIDENTIAL
UNDER PROTECTIVE ORDER

least one of said waistband portions . . . to present a soft surface at said inside of the diaper waistband despite the plastic material at the edge of the body portion." Claim 41 calls for the waist band to include "plastic material at border edges thereof" and "a padding member extending along an opposite edge portion at an exposed surface of the waist band . . . including at least one strip of material formed from a soft substance . . . forming a soft surface for contact with the skin of the individual at least one of the border edges."

As indicated above, the examiner concedes that the Gilles diaper does not meet the noted limitations in claims 26, 34 and 41 relating to the plastic layer or material. In this regard, the Gilles diaper is made essentially of cloth fabric and is not disclosed as containing any plastic layer or material of the sort required by the claims. The examiner's conclusion that it would have been an obvious matter of design choice to provide the Gilles diaper with such a plastic layer or material is not well founded.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may

not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id. Here, the examiner has failed to supply any factual basis to support the conclusion that the provision of a plastic layer or material as recited in the claims to the Gilles diaper would have been an obvious matter of design choice. Indeed, the cloth fabric construction of the Gilles diaper would appear to teach away from the proposed modification. The diaper retaining garment disclosed by McConnell is of no help to the examiner in this regard. Thus, it is evident that the examiner has resorted to speculation, unfounded assumptions and/or hindsight reconstruction to supply the acknowledged deficiency in the prior art basis for the appealed rejection.

The combined teachings of Gilles and McConnell also would not have suggested a diaper having a soft padding member as recited in independent claims 26, 34 and 41. Although both the Gilles diaper and McConnell diaper retaining garment include cloth or fabric border strips, there is nothing in these references to indicate that such strips constitute soft padding members as alleged by the examiner.

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UNDER PROTECTIVE ORDER

For these reasons, the combined teachings of Gilles and McConnell do not justify the examiner's conclusion that the subject matter recited in independent claims 26, 34 and 41 would have been obvious to one of ordinary skill in the art. Therefore, we shall not sustain the standing 35 U.S.C. § 103 rejection of these claims or of claims 27 through 33 and 35 through 39 which depend therefrom.

As a final matter, it is noted that the claims in parent Application 07/790,469 were subjected to an obviousness-type double patenting rejection based on U.S. Patent No. 5,064,421, and that such rejection was overcome by a terminal disclaimer (Paper No. 6). Given its terms, the terminal disclaimer would not appear to be effective with respect to the instant application (see MPEP 1490). Since the claims on appeal are of a scope which is similar to that of the claims which were rejected in the parent application, the examiner may wish to consider whether the claims on appeal raise an obviousness-type double patenting issue which can be obviated by the filing of a new terminal disclaimer.

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UNDER PROTECTIVE ORDER

Appeal No. 95-3512
Application 08/092,540

In any event and for the above reasons, the decision of the examiner to reject claims 26 through 39 and 41 under 35 U.S.C. § 103 as being unpatentable over Gilles in view of McConnell is reversed.

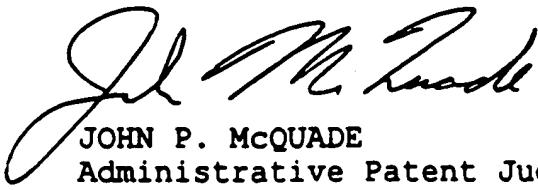
REVERSED



HARRISON E. McCANDLISH, Senior)
Administrative Patent Judge)


LAWRENCE J. STAAB
Administrative Patent Judge

)
BOARD OF PATENT
APPEALS
AND
INTERFERENCES


JOHN P. MCQUADE
Administrative Patent Judge

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UNDER PROTECTIVE ORDER

Appeal No. 95-3512
Application 08/092,540

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JPM/jrg

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ENCLOSURES:

Application _____
 Specification _____ pages
 Claims _____ pages
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 Extension of Time (In Duplicate)
 Small Entity Status
 Copy of Priority Document

RE: APPLICATION ATTY/SEC: EDM/DH
File no: TRAC-100FW CON

Applicant: Rhonda Tracy

S.N.: 09/107,643 Filing Date: 6/30/98

Title: Disposable Diaper w/ Padded
Waistband And Padded Legholes

Due date: 10/21/99 Date Sent: 10/21/99

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